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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,368	05/07/2001	Robert J. Vermillion	11114.0001U1	2544

23859 7590 11/29/2002

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ATLANTA, GA 30303-1811

EXAMINER

FORTUNA, JOSE A

ART UNIT PAPER NUMBER

1731

DATE MAILED: 11/29/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No. 09/850,368	Applicant(s) VERMILLION, ROBERT J.	
Examiner José A Fortuna	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 10-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of group I in Paper No. 9 is acknowledged. The traversal is on the ground(s) that no serious burden would be required if the groups are examined together. This is not found persuasive because the search of the article, i.e., group II, is totally different than for the composition, i.e., the layer. The layer requires the search in class 162/138, 158-168.6 the article would not require a search in class 162, but in class 428. As it can be seen there would be burden if the groups are treated together.

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "35" has been used to designate both surfaces of the paper. Also 35 has been used to designate the outer surfaces of the web and the internal layer of the paper, see figure 2A. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The use of the trademark ECCI 7091 RV has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 U.S.C. § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-4 are indefinite because the composition of ECCI 7091 RV appears to be a trademark or tradename which should be replaced by the generic description of the product. A trademark or tradename is a proprietary name used to identify the source of a good or service, not the good or service itself. The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931).

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*Claim Rejections - 35 U.S.C. § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Armington et al., US Patent No. 4,806,410.

Armington et al. teach a paper product comprising a static dissipative substance admixed with the paper, the dissipative compound does contain carbon. Armington et al. teach that the web is impregnated with liquid anti-static material, see abstract, and teach in column 5, lines 34-57, that the dissipative substance could be Calgon brand conductive polymer 261, which is the same as claimed in claims 3-4. In column 9, lines 8-34, Armington et al. teach that other anti-static agents can be used. Armington et al. also teach the same electrical resistance as claimed in claim 2, see column 2, lines 50-59 and teach the use of different types of fibers, see column 4, lines 4-12.

8. Claims 1-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yasuda, US Patent No. 3,682,696.

Yasuda teaches a static paper with is made by admixing a papermaking pulp and a dissipative substance, see abstract. Yasuda teaches that the same generic materials used as anti-static, substance, i.e., amine salts, polyethylene Glycol and quaternary ammonium compounds, see

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column 2. Even though Yasuda is silent with respect to the electrical resistance of the sheet, this property is inherent to his sheet or at least the minor modification to obtain the claimed invention would have been obvious to one of ordinary skill in the art.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-2, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Rothwell et al., US Patent No. 3,830,655 or Cessna, US Patent No. 5,089,327 or DeMatte, US Patent No. 3,902,959.

All of the above patents teach a paper which has been homogeneously impregnated with an anti-static substance/formulation. They also teach the use of virgin or recycled fibers and the use of a quaternary ammonium compound as the anti-static formulation compound. Note that the tradename claimed in claims 3-4 are quaternary ammonium compounds.

***Claim Rejections - 35 U.S.C. § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Column*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
12. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armington et al..

Armington et al. are silent with respect to the use of specif anti-static agents. However, they teach in column 9, lines 8-34 that other anti-static agents can be used. Therefore, the use of polyethylene glycol or diethanol amine, which are functional equivalent to the anti-static agent taught by Armington et al., would have been obvious to one of ordinary skill in the art, since it has been held that "[W]here two equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary." *In re Fout* 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); *In re Siebentritt*, 372 F.2d 566, 152 USPQ 618 (CCPA 1967). Note that applicants admits that the anti-static agents use in the claimed invention are well known in the art. This is further evidenced by Yasuda.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Electroconductive papers."

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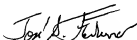
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to José Fortuna, whose telephone number is (703)305-7498. The examiner can normally be reached on Monday-Friday from 9:30 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin, can be reached on (703)308-1164. The fax number for this group is (703)305-7115.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0661.

When filing a FAX in group 1730, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

José A. Fortuna  
November 25, 2002

  
JOSÉ FORTUNA  
PRIMARY EXAMINER  
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